

## **REMARKS/ARGUMENTS**

Claims 1-6 and 21-34 are pending in the present application. Claim 22 was canceled; claims 1-2, 23-24, and 29-30 were amended; and no claims were added. Reconsideration of the claims is respectfully requested.

Support for these amendments can be found at least in page 12, line 15 to page 13, line 2; page 16, line 20 to page 17, line 7; as well as page 17 lines, 15-21 of the as-filed specification.

The cited portions of the specification are for the purpose of illustrating examples for these features and are not meant to limit the invention to the specific examples presented. Also, support for these features can be found in other portions of the specification as filed. No new matter has been added by these amendments.

Further, with respect to the claim amendments and cancelations, Applicants are not conceding in this application that the subject matter of the claims prior to the amendments and cancelations is not patentable over the art cited by the Examiner. The present claim amendments and cancelations are made only for facilitating expeditious prosecution of the application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

### **I. Interview Summary**

Applicants thank Examiner Kenneth Bartley for the courtesies extended to Applicants' representatives during the October 6, 2009 telephone interview. During the telephone interview, no agreement was reached. The arguments discussed, as well as additional reasons that the claims are patentable, are set forth in the remarks below.

### **II. 35 U.S.C. § 112, First Paragraph**

The Examiner has rejected claims 1-6 and 21-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

Office Action dated July 22, 2009, pages 3-4.

This rejection is respectfully traversed.

The Examiner states:

Claim 1, for example has "associating a transaction account with a set of communication devices ..." where there is no teaching of "transaction account" associated with communication devices in the application. A transaction is usually associated with an account (e.g. a transaction is made against a bank checking account) and is not itself an account (i.e. a transaction account). There is likely a transaction number to identify a specific transaction, or an account of some type associated with a transaction, but not an account. Claims 23 and 29 have a similar problem. It is noted that a device ID may be associated with a communication device (Fig. 1, ref. 112).

Office Action dated July 22, 2009, page 3.

Claim 1 has been amended and now recites "associating an account holder with a set of communication devices." Similar amendments have been made to claims 23 and 29.

Support for these features of claim 1 can be found at least in page 17 lines, 15-21 as well as Figure 4 of the as-filed specification. For example, the specification as filed recites "[d]atabase 400 includes device IDs for multiple devices including the account holder's mobile phone 402, pager 404, and home phone 410." Page 17 lines, 16-18.

The Examiner states:

Claim 1, for example has "associating a home address with a given identification number ..." where "home address" is not taught in the specification. The specification teaches a home. If the "location" of a store was indicated by an address in the specification, the "home address" would be permitted. There appears to be no teaching in the specification as to what a "location" means or how it is defined. Claims 23 and 29 have a similar problem

Office Action dated July 22, 2009, page 4.

Claim 1 has been amended and now recites "associating a home location with a given identification number for a single communication device." Similar amendments have been made to claims 23 and 29.

Support for these features of claim 1 can be found at least in page 12, line 15 to page 13, line 2 of the as-filed specification. For example, the specification as filed recites:

In the case where the account holder is purchasing goods or services with a vendor over the phone or via the Internet, the merchant location information can be changed to the location of the account holder, such that the two locations will match.

...

The merchant location may be changed to the account holder's current location as verified by their communication device 112, or a default "home" setting may be used.

Page 12, lines 19-21; Page 13, lines 1-2.

The Examiner states:

Claim 2 has "comparing of the location...is performed by an account service provider" where there is no teaching of an account service provider comparing locations. From the instant application:

"The point of sale terminal 102, contacts a transaction service provider or central computer 104, typically via a telephone call. When the phone call is connected, the point of sale terminal 102 initializes communication with the service provider central computer 104. The service provider typically validates the transaction card. This may include checking with the actual card issuer to make sure the proposed procurement would not exceed predetermined maximum purchase limits." ([0024] of Pub No US 2003/0135463)

Claims 23 and 29 have similar problems.

Office Action dated July 22, 2009, page 4.

Claim 2 has been amended and now recites "comparing the location of the single communication device with the home location of the account holder is performed by an account service provider." Similar amendments have been made to claims 24 and 30.

Support for these features of claim 2 can be found at least in page 12, line 15 to page 13, line 2 as well as page 16, line 20 to page 17, line 7 of the as-filed specification. For example, the specification as filed recites:

The merchant location may be changed to the account holder's current location as verified by their communication device 112, or a default "home" setting may be used.

...

With the location information in hand, the remote transaction service provider, then determines at step 312 whether the location of the communication device matches the location of the merchant.

Page 12, lines 19-21; Page 16, lines 3-5.

The above cited portions of the specification are for the purpose of illustrating examples for these features and not meant to limit the invention to the specific examples present. Also, support for these features can be found in other portions of the specification as filed. No new matter has been added by these amendments.

As demonstrated by the above cited portions of the specification, Applicants respectfully submit that the claims, as amended, are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Therefore, the objection of the specification under 35 U.S.C. § 112, first paragraph has been overcome.

### **III. 35 U.S.C. § 102, Anticipation**

The Examiner has rejected claims 1-6 and 21-34 under 35 U.S.C. § 102(e) as being anticipated by Hultgren (U.S. Patent Application No. 6,868,391) Office Action dated July 22, 2009, pages 5-8. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Because the hallmark of anticipation is prior invention the prior art reference – in order to anticipate under 35 U.S.C. § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1543, 1548 (Fed. Cir. 1983). To anticipate a claim, a single prior art reference must expressly or inherently disclose each limitation . . . . But disclosure of each element is not quite enough – this court has long held that “[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Id.* at 1334 (quoting *Connell*, 722 F.2d at 1548).

In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims. Claim 1 has been amended and now recites:

A computer implemented method for authorizing transactions against an account for a transaction occurring over an internet site, the computer implemented method comprising:

- associating an account holder with a set of communication devices;
- storing the set of communication devices with a set of corresponding identification numbers in a database for the account holder, wherein each communication device from the stored set of communication devices is adapted to transmit a physical location of the each communication device;
- associating a home location with a given identification number for a single communication device, wherein the home location corresponds to the home

location of the account holder, and wherein the single communication device is one of the stored set of communication devices;

    receiving a transaction request for the transaction occurring on the internet site, wherein the transaction request comprises an account number associated with the account holder and a merchant associated with the transaction;

    obtaining a location of the merchant to form a merchant location;

    responsive to receiving a unique character string from the account holder, changing the merchant location to the home location of the account holder; comparing a location of the single communication device with the home location of the account holder; and

    responsive to detecting a match between the location of the single communication device with the home location of the account holder, authorizing the transaction occurring over the internet site.

Office Action dated July 22, 2009, pages 5-8.

Hultgren does not disclose “responsive to receiving a unique character string from the account holder, changing the merchant location to the home location of the account holder” as recited in the overall combination of claim 1. This feature of claim 1 has been added by amendment. In the previous office action, the Examiner cited to the following portion of Hultgren:

At step 308B of FIG. 4B, transaction security module checks whether customer mobile station 60 is within a predetermined geographical proximity of a registered customer predetermined native location. In particular, transfer communication module 206 passes to transaction security module 212 the customer GPS location coordinates obtained at step 306 and the current GPS coordinates of customer mobile station 60. Transaction security module 212 then compares the customer GPS location coordinates obtained at step 306 and the current GPS coordinates of customer mobile station 60.

Hultgren, column 11, lines 11-18.

However, this portion of Hultgren does not disclose the above recited features of claim 1. Hultgren is directed to a communications network for facilitating payment from a customer account to a merchant account. See Hultgren, abstract. The above cited portion discloses “check[ing] whether customer mobile station is within a predetermined geographical proximity of a registered customer predetermined native location.” Hultgren, column 11, lines 12-14. This portion of Hultgren merely discloses checking proximities. Hultgren fails to disclose changing of any locations and changing of any locations “responsive to receiving a unique character string from the account holder.”

In another portion, Hultgren discloses “check[ing] whether customer mobile station is within a predetermined geographical proximity of merchant terminal.” Hultgren, column 10, lines 28-29. This portion of Hultgren may disclose checking a proximity to a merchant terminal. This portion of Hultgren also fails to disclose changing of any locations and changing of any locations “responsive to receiving a unique character string from the account holder.”

In another portion, Hultgren discloses “the invention requires that the customer also know a customer account identifier (PIN) in order to effect the transaction with a measure of security.” Hultgren, column 11, lines 48-50. This portion of Hultgren may disclose requiring knowledge of an account identifier. Requiring knowledge is not the same as changing of any locations “responsive to receiving a unique character string from the account holder.” Also, effecting a transaction with a measure of security does not disclose the above recited features of claim 1 either. Hultgren merely discloses effecting a transaction. This portion of Hultgren fails to disclose changing of any locations and changing of any locations “responsive to receiving a unique character string from the account holder.”

Anticipation requires not only disclosure of all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1543, 1548 (Fed. Cir. 1983). As shown above, Hultgren fails to disclose all the elements of claim 1. Additionally, Hultgren fails to disclose the elements of claim 1, as arranged in the claim. Accordingly, Hultgren does not anticipate claim 1.

Similar limitations and features are recited in independent claims 23 and 29, and the same arguments with respect to claim 1 apply to claims 23 and 29 as well. Therefore, for at least the reasons discussed above with respect to claim 1, claims 23 and 29 are also not anticipated by Hultgren.

Since dependent claims 2-6, 21, 23-28, and 30-34 depend from and further restrict one of independent claims 1, 23 and 29, the same distinctions between Hultgren and the claims 1, 23 and 29 exist for these dependent claims. Accordingly, 2-6, 21, 23-28, and 30-34 are also not anticipated by Hultgren at least by virtue of their dependency. Claim 22 has been canceled. The rejection of claim 22 is now moot.

Therefore, the rejection of claims 1-6 and 21-34 under 35 U.S.C. § 102(e) has been overcome.

Furthermore, Hultgren does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent some teaching, suggestion, or

incentive to modify Hultgren, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

#### **IV. Conclusion**

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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